

An appropriate Terminal Disclaimer is enclosed herewith. In view thereof, reconsideration and withdrawal of the rejection are requested.

Claim 25 was provisionally rejected under the doctrine of obviousness-type double-patenting over certain claims of co-pending application no. 09/927,040.

Claim 25 has been cancelled without prejudice herein. It is thus believed the rejection is properly withdrawn.

Originally presented claim 13 was rejected under 35 U.S.C. 112, first paragraph. In the Office Action, the following is stated:

Applicant has not pointed out where the new claim limit is supported, nor does there appear to be a written description of the claim limitation in question in the application as filed. Each working example set forth in the application has a fused anhydride ring present.

The rejection is traversed.

As an initial matter, claim 13 is an originally presented claim. The subject matter of claim 13 is also disclosed for instance at page 6, lines 10-14 of the application.

With regard to examples of the application including polymers that have anhydride groups, original claim 13 does not recite that the polymer is free of anhydride groups; rather, the claim recites that the referred-to unit is not an anhydride or lactone.

In view thereof, reconsideration and withdrawal of the rejection are requested.

Claims 1-2, 4-5, 8, 13, 23-24, 35 and 41 were rejected under 35 U.S.C. 102 over Yool et al. (EP 086119).

Claims 1-2, 4-5, 23-24 and 35 were rejected under 35 U.S.C. 102 over Seo et al. (U.S. Patent 6,146,810 or EP 0989462).

Claims 1-2, 4-5, 23-24, 35 and 41 were rejected under 35 U.S.C. 102 over Jung et al. (U.S. Patent 6,150,069).

Claims 1-2, 4-5, 24, 35 and 41 were rejected under 35 U.S.C. 102 over Sumino et al. (U.S. Patent 6,143,472).

Claims 1-2, 4-5, 8, 23-24, 35 and 41 were rejected under 35 U.S.C. 102 over Houlihan et al. (U.S. Patent 5,843,624).

Claims 25-26 were rejected under 35 U.S.C. 102 over Schwalm et al. (U.S. Patent 5,130,392).

For the sake of brevity, the above Section 102 rejections are addressed in combination.

None of the cited documents disclose or otherwise suggest heteroalicyclic groups that are fused to a polymer backbone that are not anhydride or lactone groups as recited in Applicants' pending claims.

In view thereof, the rejections should be withdrawn. See, for example, *In re Marshall*, 198 USPQ at 346 ("Rejections under 35 USC 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art.")

Claims 25-26 were rejected under 35 U.S.C. 102 over Schwalm et al. (U.S. Patent 5,130,392).

Claims 25-27 were rejected under 35 U.S.C. 102 or, in the alternative, under 35 U.S.C. 103 over Schwalm (U.S. Patent 5,130,392).

Claims 25-26 were rejected under 35 U.S.C. 102 over Schwalm (U.S. Patent 5,453,341).

Claim 25 was rejected under 35 U.S.C. 102 over Binder et al. (U.S. Patent 5,759,750).

Claim 25 was rejected under 35 U.S.C. 102 over Willson et al. (U.S. Patent 6,103,445).

Claims 25-26 were rejected under 35 U.S.C. 102 over Chang et al. (U.S. Patent 6,197,476).

Claims 25-27 were rejected under 35 U.S.C. 103 over Hasegawa et al. (U.S. Patent 6,280,898).

Claims 25 and 27 were rejected under 35 U.S.C. over Taylor et al. (EP 0915382).

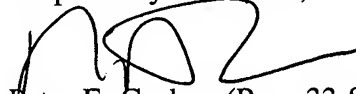
For the sake of brevity, the above rejections are addressed in combination.

Claims 25-27 have been cancelled without prejudice. It is thus believed the rejections are obviated.

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It is believed the present application is in condition for immediate allowance, which action is earnestly solicited.

Respectfully submitted,



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**VERSION TO SHOW MARKED CHANGES**

**IN THE SPECIFICATION**

Please amend the priority claim at page 1, line 1 of the application to read as follows:

The present application is a continuation of International Application no. PCT/US01/14914 filed May 8, 2001, which is a continuation of U.S. application no. 09/567,634 filed May 9, 2000.

**IN THE CLAIMS**

1. (amended) A photoresist comprising a photoactive component and a polymer that comprises: i) a heteroalicyclic group ~~that is not an anhydride or lactone and is fused to the~~ polymer backbone and that contains one or more oxygen or sulfur ring members; ii) a carbon alicyclic group fused to the polymer backbone; and iii) a photoacid-labile moiety.